

## **REMARKS**

Claims 1, 3-7, 9, 11-19, 21, 23 and 25-27 were pending in the application. Claims 1 and 14 have been amended. Claims 26-27 have been cancelled. Claims 1, 3-7, 9, 11-19, 21, 23 and 25 remain pending in the application. Applicant notes that the subject matter of now-cancelled claims 26 and 27 has been incorporated into claims 1 and 14, respectively, and thus believes that the amendments to the claims do not raise any new issues of patentability.

### **Objection to the Claims:**

Claims 26 and 27 were objected to for informalities. In light of the cancellation of claims 26 and 27, Applicant believes this objection to be moot.

### **35 U.S.C. § 103 Rejection:**

Claims 1, 3-7, 9, 11-19, 21, 23 and 25-27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Sartore, U.S. Patent 6,012,103, in view of Clarke, U.S. Patent 4,916,692. Applicant respectfully traverses this rejection.

**The prior art does not suggest the desirability of the claimed combinations of features.** Independent claim 1 recites, in pertinent part:

“reading configuration information from the peripheral device, wherein the configuration information includes device identification information, wherein said reading is performed over a serial side bus, wherein the serial side bus is separate from peripheral bus, wherein the serial side bus is coupled to the host controller and the peripheral device” (Emphasis added).

Independent claim 14 recites a similar combination of features.

In rejecting the features of claims 26 and 27 (now incorporated into claims 1 and 14, respectively), the Examiner agrees that Sartore does not teach or suggest a serial side bus. However, the Examiner contends that it would have been obvious to provide a

separate serial side bus, and that a suggestion or motivation would have been to make the functions separable so as to reduce bus congestion on a single bus. In support of this argument, the Examiner cites *Dulberg*, 289 F.2d 522, 523, 129, USPQ 348, 349, CCPA, 1961 (The claimed structure, a lipstick holder with a removable cap, was fully met by the prior art except that in the prior art the cap is “press fitted” and therefore not manually removable. The court held that “if it were considered desirable for any reason to obtain access to the end of [the prior art’s] holder to which the cap is applied, it would be obvious to make the cap removable for that purpose.”).

Applicant submits that the facts of the pending application are different than those of the cited case above. In contrasting the facts, Applicant submits that providing a serial side bus separate from a peripheral bus is not equivalent to the facts of the *Dulberg* case, wherein the cap of a lipstick holder was made removable.

The question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 488 (Fed. Cir. 1984). “The factual inquiry whether to combine references must be thorough and searching.” *McGinley v. Franklin Sports, Inc.*, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001). It must be based on objective evidence of record. “This precedent has been reinforced in myriad decisions, and cannot be dispensed with.” *In re Sang Su Lee*, 61 USPQ2d 1430 (Fed. Cir. 2002). “The need for specificity pervades this authority.” *Id.* “Particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.” *In re Kotzab*, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). Applicant asserts that the Examiner has not satisfied the rigorous tests for properly combining references to establish obviousness. Instead, as discussed above, the Examiner’s reasoning is not supported by the teachings of the references, lacks specificity, and is based in hindsight.

As the Court of Appeals for the Federal Circuit recently explained in *In re Sang Su Lee*, Docket No. 00-1158 (Fed. Cir. January 18, 2002), conclusory statements such as

those provided by the Examiner that a claim limitation is well known or common knowledge do not fulfill the Examiner's obligation. "Deficiencies of the cited references cannot be remedied by the [Examiner's] general conclusions about what is 'basic knowledge' or 'common sense.'" *In re Zurko*, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). "Common knowledge and common sense ... do not substitute for authority." *In re San Su Lee*. Common knowledge "does not in and of itself make it so" absent evidence of such knowledge. *Smiths Industries Medical Systems, Inc. v. Vital Signs, Inc.*, 51 USPQ2d 1415, 1421 (Fed. Cir. 1999).

Applicant respectfully submits that none of the cited references teach or suggest, or provide any motivation for providing the combination of features as recited in claim 1 including "a serial side bus, wherein the serial side bus is separate from peripheral bus". Accordingly, Applicant submits that claim 1 along with its dependent claims is in condition for allowance. Similarly, Applicant respectfully submits that none of the cited references teach or suggest, or provide any motivation for providing the combination of features as recited in claim 14, including "over a serial side bus, wherein the serial side bus is separate from peripheral bus". Accordingly, Applicant submits that claim 14 along with its dependent claims is in condition for allowance.

## CONCLUSION

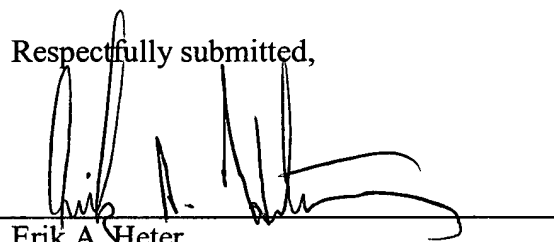
Applicant submits the application is in condition for allowance, and an early notice to that effect is requested.

If any extensions of time (under 37 C.F.R. § 1.136) are necessary to prevent the above referenced application(s) from becoming abandoned, Applicant(s) hereby petition for such extensions. If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C. Deposit Account No. 501505/5500-58300/BNK.

Also enclosed herewith are the following items:

☒ Return Receipt Postcard

Respectfully submitted,



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